

REMARKS

This is in response to the Notice mailed March 22, 2011 that the Amendment and Response to the Office Action, dated December 13, 2010 in the above-identified application presented claims outside the scope of the elected invention.

The independent claim 17 has been amended to revert back to the language of claim 17 prior to the last amendment and to include limitations found in original claim 20. Claim 19 has been cancelled as a result of this amendment.

Claims 17, 20-21, 24 and 25 are pending.

§103 Rejections

Claims 17, 19-21, 24 and 25 are rejected under 35 U.S.C. 103(a) as obvious over Leys et al., (US 2002-0036017) in view of McPeak et al., (US 6880808). Applicants disagree.

Cited Art Fails to Disclose All Claimed Elements

The **independent claim 17** includes, at least, the second material **comprises a thermosettable elastomer**, to form the sealing element” and that the sealing element is co-molded with the stem element. The cited references do not disclose or suggest this. Thus, the pending claims are not obvious over the cited art.

The pending application specifically describes the phrase “the sealing element is co-molded with at least a portion of the elongate stem element” at paragraph [0036] as: the sealing element is chemical and/or mechanical bonded to at least a portion of the elongate stem element as the result of a co-molding process. The cited references do not disclose this.

As described in paragraph [0054] of the pending application, Applicants have discovered that claimed method of making a valve stem where the valve stem is a polymer selected from the group consisting of polyaryletherketones, thermotropic liquid crystalline polymers, polymethylpentene, polyphenylene sulfide and mixtures thereof to form the elongate stem element that is co-molded with sealing element being a thermosettable elastomer, provides a valve stem with unique and unexpected advantages that are not appreciated in the cited art. In particular paragraph [0054] states:

Due to the desirable structural properties of the valve stems, in particular the elongate stem element thereof, in regard to resistance to thermal stress and deformation the valve stems are particularly advantageous in allowing the provision of such valve stem comprising co-molded sealing elements made of materials comprising thermoset elastomers.

Applicants assert that at least these advantages are not appreciated in the cited art.

The Office Action simply states that use of a specific material is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. This statement is clear error and lacks any evidential weight. Applicants specifically traverse this assertion and request evidence that supports the assertion as is required by the MPEP.

Applicants assert that a *prima facie* case of obviousness has not been established. In particular one of ordinary skill in the art at the time of the invention would not have modified Leys with any known material as an obvious matter of choice as asserted in the Office Action.

As stated in the KSR case:

a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new inventions does.

KSR Int'l v. Teleflex Inc., 127 S.Ct. 1727, 1741 (2007). In addition, KSR states:

there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

Id.

The Office Action provides no reasoning to modify Leys as suggested. Failure to provide any reasoning is clear error.

Just because the elements of claim -- were independently known in the art, does not lead to a conclusion of obviousness unless the examiner can articulate a reason with some rational underpinning to support the legal conclusion of obviousness that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new inventions does. See KSR. The Office Action does not any reason much less a reason with some rational underpinning to support the legal conclusion of obviousness that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new inventions does. Therefore, the Office Action does not establish a *prima facie* case of obviousness.

Reconsideration and withdrawal of the rejection is respectfully requested.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Allowance of claims 17, 20-21, 24 and 25, as amended, at an early date is solicited.

Respectfully submitted,

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